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EXAMINER

HUYNH, CONG LAC T

ART UNIT

PAPER NUMBER

2178

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/304,204

Applicant(s)

GROPPER ET AL.

Examiner

Cong-Lac Huynh

Art Unit

2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 February 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 26-34 is/are allowed.
- 6) ☒ Claim(s) 1,2,7,11,12,15-25 and 35-37 is/are rejected.
- 7) ☒ Claim(s) 3-6,8-10,13 and 14 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is responsive to communications: amendment filed on 2/11/03 to the application filed 5/3/99.
2. Claims 1-37 are pending in the case. Claims 1, 12, 19, 26, 35 are independent claims.
3. The rejections of claims 12-18 under 35 U.S.C. 112, second paragraph as being indefinite have been withdrawn in view of the amendment.
4. The rejections of claims 35-37 under 35 U.S.C. 103(a) as being unpatentable over Kraft, IV in view of Campbell have been withdrawn in view of Applicants' arguments.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.
6. Claims 35-37 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Regarding independent claim 35, the claim is directed to **a format for an endnote** for use with a linked report *comprising a character information portion, a view state information, and a workflow state information portion*. The format of the endnote as claimed is a non-statutory subject matter since said format is not either a process, a machine, a manufacture, or a composition of matter.

Dependent claims 36-37 are rejected for fully incorporating the deficiencies of their base claim.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

8. Claims 1 and 12 remain rejected under 35 U.S.C. 102(a) as being anticipated by Kraft, IV (US Pat No. 5,870,767, 2/9/99, filed 11/22/96).

Regarding independent claim 1, Kraft discloses a document comprising:

- a text section (figure 7, the text section above the broken line)
- an endnote section, the endnote section being independent of the text section and including information for linking portion of text contained in the text section to predetermined link information, *without altering the text section* (figure 7: the endnote section below the broken line includes the hyperlink address that are the link information of text contained in the text section to predetermined link information without altering the text section since there is no change such as an image embedded in the text section of the document)

Though Kraft does not explicitly mention a report, the hypertext document in Kraft inherently includes a report since a report is merely a form of document.

Regarding independent claim 12, Kraft discloses:

- creating the text for a document (figure 8, #138-#140, the hypertext document selection by the graphical user interface inherently shows that the text document is created; col 7, line 64 to col 8, lines 1-4)
- retrieving link information to be displayed along with the text in association with a predetermined portion of the text (figure 6, #124; figure 7, #130, #134; figure 8, #142)
- creating an independent endnote containing information sufficient to link said predetermined text portion and link information (figure 8, #144, generate footnote, #146, associate footnote with hyperlink address which is included in the text portion)
- attaching the endnote to the document after the text without altering the text section (figure 7, the endnote is attached to the document after the text without altering the text section since there is no change such as an image embedded to the text section)

As in claim 1 above, though Kraft does not explicitly mention a report, the hypertext document in Kraft inherently includes a report since a report is merely a form of document.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 2178

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

11. Claims 2, 16 and 19 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Kraft, IV (US Pat No. 5,870,767, 2/9/99, filed 11/22/96).

Regarding claims 2 and 16, which are dependent on claims 1 and 12 respectively, Kraft does not disclose that said link information includes an image. However, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified Kraft to include an image into the link information since it was well known in the art that a hyperlink can be in text or image form.

Regarding independent claim 19, Kraft discloses:

- opening and displaying the text at a terminal (figure 8, #138, #140)

- activating the link (figure 6, #124, col 7, lines 40-49, IBM link is activated by user clicking)
- identifying the appropriate endnote corresponding to the activated link (figure 7, the endnote include the activated link)

Kraft does not disclose retrieving link information at an address in accordance with information included in the endnote and displaying said retrieved link information.

Instead Kraft discloses that from the graphical interface includes, a user can select a command from a pull down menu for viewing or printing a selected data (col 6, lines 24-67).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified Kraft to include retrieving link information at an address in accordance with information included in the endnote and displaying said retrieved link information since a user can select the link information in accordance with the information included in the endnote for displaying instead of selecting other data for displaying from the menu.

12. Claims 7, 11, 15, 17-18, 20-25 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Kraft as applied to claims 1,12, 19 above, and further in view of Nielsen (US Pat No. 6,199,071 B1, 3/6/01, filed 4/1/97).

Regarding claim 7, which is dependent on claim 1, Kraft does not disclose that said endnote section includes a plurality of endnotes.

Nielsen discloses the endnote section includes a plurality of endnotes (figures 9B-C; col 12, lines 16-30).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined Nielsen into Kraft to enhance the endnote section creating with more data included in the endnote section.

Regarding claim 11, which is dependent on claim 1, Kraft does not disclose an end marker being a signature.

Nielsen discloses a note "An internal Reference" at the end of the text section (figures 9B-C). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified Nielsen to include a signature as an end marker of the text section since a signature is merely a short text as a short note.

Regarding claim 15, which is dependent on claim 12, Kraft does not disclose that the endnote includes text modification *instructions for modifying the display* of the predetermined portion of the text to indicate that characters contained in the predetermined portions are linked.

Nielsen discloses that the endnote includes *an instruction for viewing a note* which is in a predetermined portion of the text to indicate that the character contained in the predetermined portions are linked (figures 9B-C).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified the instruction of Nielsen "See note #2" to include text

modification instructions for modifying the display of the predetermined portion of the text to indicate that characters contained in the predetermined portions are linked since it is possible to replace another instruction in the endnote.

Also, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined Nielsen into Kraft to enhance the endnote creation where the content of the endnote may include both the link information or any instruction related to the text document.

Regarding claims 17 and 18, which are dependent on claims 11 and 17 respectively, Kraft does not disclose providing an end of text marker after the text and attaching the endnote to the report after the end of the text marker wherein the end of text marker is a signature.

As mentioned in claim 11 above, Nielsen discloses the note "An internal Reference" at the end of the text section (figures 9B-C).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified Nielsen to include a signature as an end marker of the text section since a signature is merely a short text as a note.

Also, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined Nielsen into Kraft to easily differentiate each separate section in a document by a signature as end marker to mark at the end of each section.

Regarding claim 20, which is dependent on claim 19, Kraft does not disclose that the endnote includes text modification *instructions for modifying the display* of the text to be linked and modifying the display of the text in accordance with the instructions.

Nielsen discloses that the endnote includes *an instruction for viewing a note* which is in the display of the text to indicate the portion of the text to be link (figures 9B-C, the endnote includes the instruction "See note #2").

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified the instruction of Nielsen "See note #2" to include text modification instructions for modifying the display of the text to indicate the portion of the text to be linked since one can replace one instruction by another instruction.

Also, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined Nielsen into Kraft to enhance the endnote content to include a modifying instruction for modifying the selected text in accordance with the instructions in addition to displaying and printing instructions.

Regarding claim 21, which is dependent on claim 19, Kraft and Nielsen do not disclose retrieving the link information from a repository.

However, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified Kraft and Nielsen to include retrieving the link information from a repository since it was well known in the art that all the information data is stored in a database, which is a repository, for retrieving data later on.

Regarding claim 22, which is dependent on claim 19, Kraft discloses that the link information is a web site (figure 7, #130).

Regarding claim 23, which is dependent on claim 19, Kraft does not disclose providing an end marker at the end of the text section and reading the text portion line by line into a temporary memory as text until the signature is read, and operating on the endnote operation so that each line of text is processed as a separate data structure.

Nielsen discloses the note "An internal Reference" at the end of the text section (figures 9B-C).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified Nielsen to provide a signature as an end marker of the text section since a signature is merely a short text as a note to indicate the end of a section.

Further, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified Nielsen to include "reading the text portion line by line...until the signature is read" and "operating on the endnote...."since for storing a document with an end marker at the end of the text section and the attached endnote, the system has to read the document character by character until the signature, which is the end of the text section, to store the text section data in the memory, and then read the text on the endnote as a separate data structure. Since each line includes a number of characters, reading characters in the lines is considered as reading line by line.

Regarding claim 24, which is dependent on claim 23, Kraft does not disclose operating upon each line of text by inserting said line of text into a Java Swing document, and

modifying the text in accordance with the instructions stored in the endnote to indicate where links exist.

Instead Kraft discloses the commands in the menu for displaying and printing documents (col 6, lines 24-67).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified the Kraft menu to incorporate the inserting and modifying commands for modifying documents in text section or in the endnote section to enhance menu commands applied on the documents.

Regarding claim 25, which is dependent on claim 19, Kraft does not disclose providing an end marker at the end of the text section and reading the text portion *character by character* into a temporary memory as text until the signature is read, and operating on the endnote operation so that each line of text is processed as a separate data structure.

Nielsen discloses the note "An internal Reference" at the end of the text section (figures 9B-C).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified Nielsen to provide a signature as an end marker of the text section since a signature is merely a short text as a note to indicate the end of a section.

Further, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified Nielsen to include "reading the text portion

character by character...until the signature is read" and "operating on the endnote...."since for storing a document with an end marker at the end of the text section and the attached endnote, the system has to read the document character by character until the signature, which is the end of the text section, to store the text section data in the memory, and then read the text on the endnote as a separate data structure.

13. Claim 26 remains rejected under 35 U.S.C. 103(a) as being unpatentable over Camphell et al. (US Pat No. 6,208,974, 3/27/01, filed 12/30/97).

Regarding independent claim 26, Camphell does not disclose:

- creating an endnote having a workflow state portion and encoding the protocol in said workflow state portion
- the endnote including a work state indicator, and storing a workflow state in the workflow state indicator
- performing a step in the protocol and changing the workflow state value stored in said workflow state indicator to indicate the performed step has been completed

Instead Camphell discloses:

- a workflow state portion and the protocol of said workflow state portion (figure 10, #1004, #1006; col 17, line 51 to col 18, lines 1-5)
- a work state indicator and storing a workflow state in the workflow state indicator (figure 10, #1008; col 17, line 65 to col 18, lines 1-5, "the series of check buttons that enables the user to record the status of the treatment protocol" shows that

the status of the treatment protocol, which is considered as a workflow state, is recorded in check buttons as state indicators)

- performing steps in the protocol and showing that the performed step has been completed (figure 10, #1006, Otoscopic Exam – complete)

Though Camphell does not disclose creating an endnote including the workflow state portion, Camphell discloses the workflow state portion and the workflow state indicator in a document.

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified Camphell to incorporate an endnote of a document to include the workflow state portion and the workflow state indicator since the endnote is also a section of a document.

Allowable Subject Matter

14. Claims ~~26~~¹/34 are allowed.

15. The following is a statement of reasons for the indication of allowable subject matter: a method for creating a report based on a protocol including the steps of creating an endnote having a workflow state portion and including a work state indicator and encoding the protocol in said workflow state portion, storing a workflow state in the work state indicator, and performing a step in the protocol and changing the workflow state value stored in said workflow state indicator to indicate the completion of the performed step, was not disclosed by, and would not have been obvious to a person of ordinary skill at the time of the invention over the prior art of record.

16. Claims 3-6, 8-10, 14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

17. Applicant's arguments filed 2/11/03 have been fully considered but they are not persuasive.

Applicants argue that Kraft does not teach that the endnote section includes "information for linking portion of text contained in the text section to predetermined link information, without altering the text section" as amended claim 1. Applicants provide the support for that feature in the Detailed Description of the Preferred Embodiments on page 6 of the specification (Remarks, page 4).

However, the Examiner does not see any part in that page that discloses the argued feature. Actually, page 6 merely discloses the report 26 as seen in figure 3 with the written text 22, a signature 28 and the endnote 30 where the endnote 30 includes the information necessary to link the desired image to the appropriate portion of text 22.

Nothing about the specific feature of "without altering the text section" as amended is mentioned. Therefore, that feature is not supported in the specification as argued.

Regarding independent claims 1 and 12, Applicants also argue that "Kraft does not teach or suggest use of an independent endnote section including information for linking portions of text contained in a text section to predetermined link information, without

altering the text section" (Remarks, page 4). Applicants point out the reason that the document in figure 7 of Kraft includes numerous alterations to the "text section" in the form of reference numbers which alter the contents of the "text section" of the document, violating one of the objects of the invention in the summary of the invention (specification, pages 3 and 4), and teaching away from the limitations of claim 1, as amended.

Examiner respectfully disagrees.

As disclosed in the specification, embedding images is a form of modifying the text of the medial report to illustrate the text portion. Such embedding has a drawback that it could result in misdiagnosis or mistreatment and thus jeopardizing the integrity of the report. To overcome the shortcomings, endnotes and web page hyperlinks are provided to link the text to a desired address which will retrieve the required illustrative information as needed and display the link information along with the text (specification, page 2).

Therefore, in light of the specification, the feature of "without modifying the content of the report" as disclosed in the Summary of the invention (page 3) means without embedding images into the text section of the report since such image embedding alters the text section of the report. To link an image to text without image embedding, the image is linked to specific characters in the text section where the link information is included in the endnote (pages 3-4). The display of the text of the linked characters is modified and the linked information may either be the address of stored images and data at a repository, or maybe another related web site (page 3). The text in the text

section where links exist is modified such as changing color or underline to indicate the linking (page 10).

The document in figure 7 of Kraft has a text section and an endnote section where the text section does not have any image embedded in the text section, and the endnote section includes information for linking portions of text contained in the text section to predetermined linked information, which is the hyperlink address. Therefore, there is *nothing in the document that can alter the text section*. The reference numbers as mentioned by Applicants are merely the indications in the text section to show that there are linkings at the specific parts in the text section to the linked information included in the endnote section. The reference numbers next to the string characters in Kraft are equivalent to the text with changing color or underline or the modified linked characters to indicate where the links exist in the text section as disclosed in the invention. The reference numbers should be included in the text section when creating the document as linking indications. *Without such indications, no one can tell where in the text of the text section the links exist*. Therefore, **the reference numbers in Kraft do not alter the text section as argued**.

Dependent claims 2-11, 13-18 are rejected for fully incorporating the deficiencies of their base claims 1 and 12 respectively.

Regarding independent claim 19, Applicants argue that the portion as cited in Kraft (col 6, lines 24-67) does not teach or suggest "retrieving link information at an address in

accordance with information included in the endnote and displaying said retrieved link information" (Remarks, page 5).

Examiner does not agree.

Since the graphical user interface of Kraft includes the pull down menu for user to select a command such as for viewing or printing the selected data, a user can select to view the link information in accordance with the selected information included in the endnote.

It is true that the endnote shown in figure 7 appear in a hardcopy printout of the document, which is generated when a user chooses to print the document. However, the endnotes are displayed on the graphical user interface before rendering document as a hardcopy (figure 8, #144, #146, #148). The pull down menu and the display of the endnotes on the graphical user interface suggest that the user can enter the hyperlink address as seen in the endnotes to request retrieving the link information at the address included in the endnotes.

Conclusion

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Walker et al. (US Pat No. 5,995,976, 11/30/99, filed 10/11/96).

Feigner et al. (US Pat No. 6,246,404 B1, 6/12/01, filed 3/18/99, priority 1/31/97).

Chiang et al. (US Pat No. 5,493,658, 2/20/96, filed 10/20/94).

Pelletier et al. (US Pat No. 5,579,519, 11/26/96, filed 2/16/94).

Dooley (US Pat No. 5,893,916, 4/13/99, filed 12/13/96).

Art Unit: 2178


Kolster (US Pat No. 5,920,877, 7/6/99, filed 6/17/96).

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cong-Lac Huynh whose telephone number is 703-305-0432. The examiner can normally be reached on Mon-Fri (8:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on 703-308-5186. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 707-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-9000.

clh
5/1/03


STEPHEN E. HONG
PRIMARY EXAMINER